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REMARKS

Applicant has carefully reviewed the office action mailed April 7, 2006 and offers the following remarks.

Claims 1-3, 5-11, 13-18, and 27-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,128,730 to Levine (hereinafter "Levine") in view of U.S. Patent No. 6,405,362 to Shih et al. (hereinafter "Shih) and further in view of an article by Lin et al. entitled "Taking the Byte Out of Cookies" (hereinafter "Lin"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once a proper combination has been made, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is shown. MPEP § 2143.03.

Applicant initially submits that the Patent Office has failed to support its stated motivation to combine the references with actual evidence as is required by applicable Federal Circuit case law. Applicant is aware that most inventions are combinations of known elements. One of the things that makes an invention patentable is that there was no suggestion to combine the known elements in the manner claimed. To avoid impermissible hindsight reconstruction, the Federal Circuit, in *Dembiczak*, acknowledged earlier case law that set forth various sources from which a suggestion to combine references may come, but reiterated that the range of available sources does not diminish the requirement for actual evidence to support the stated motivation to combine. *In re Dembiczak* at 999. In the present application, the Patent Office has not complied with the requirements set forth by the Federal Circuit. Specifically, the Patent Office asserts that the motivation to combine the references is "because the cookie is used to provide the user with a customized service." (Office Action mailed April 7, 2006, page 4). This asserted motivation lacks the required actual evidence to support it. In addition, the Patent Office has provided no rationale of why a person of ordinary skill in the art reading Shih would be interested in customized service. Therefore, the motivation itself has no rationale to support it. Since the motivation lacks both supporting rationale and the required actual evidence, the motivation is improper. Since the motivation is improper, the combination of references is

improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

In addition, the Patent Office has asserted that it would have been obvious to a person of ordinary skill in the art to use the configuration file of Shih as a cookie as in the teachings of Lin. However, as set forth below, a person of ordinary skill in the art would not even consider a configuration file and a cookie as being analogous, much less as being interchangeable. Certainly, the Patent Office has provided no evidence to support the conclusory statement that it would be obvious to a person of ordinary skill in the art to use the configuration file of Shih as a cookie. Since the Patent Office has provided no evidence to support its statement that the proposed combination would be obvious, the proposed combination of references is improper. Since the combination is improper, the rejection is improper, and the claims are allowable.

Applicant still further traverses the rejection because the Patent Office has not established *prima facie* obviousness. Specifically, even if the combination is proper, a point Applicant does not concede, the combination of references does not show each and every element of the claimed invention. Claim 1 recites software adapted to automatically execute on the host computing device in association with a computing session and configure other software running on the host computing device and, in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session, said removed records including one or more of the group consisting of browsing histories, cookies, preferences, favorites, and bookmarks from one or more of the group consisting of system memory, cache, and disk drives. The proposed combination does not teach the above element.

The Patent Office admits that Levine does not disclose software adapted to automatically execute on the host computing device and that Levine does not disclose a system that performs cleanup functions (Office Action mailed April 7, 2006, p. 3). However, the Patent Office asserts that Shih teaches these elements. In particular, the Patent Office asserts that Shih teaches software adapted to automatically execute on the host computing device in association with a computing session and configure other software running on the host computing device (col. 6, line 56 to col. 7, line 40), and, in association with termination of the computing session, instruct the host computing device to remove records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session (col. 8, line 35 to

col. 9, line 53). In addition, the Patent Office asserts that Shih discloses software that is adapted to instruct the host computing device to delete the configuration files (col. 9, lines 35-53) (Office Action mailed April 7, 2006, p. 3).

In the previous response, Applicant pointed out that while the cited passages of Shih do discuss cleanup functions, the passages do not discuss removing browsing histories, cookies, preferences, and bookmarks as recited in the claim (Office Action Response mailed January 18, 2006, p. 7). Rather, Shih teaches removing registry entries, icons from the task bar, and the like (see Shih, col. 7, lines 64-67 and col. 9, lines 40-45). The Patent Office now admits that Shih does not disclose removing browsing histories, cookies, preferences, and bookmarks as recited in the claim (Office Action mailed April 7, 2006, p. 4) ("Shih does not disclose that configuration file corresponds to the cookies as recited in the claim."). Instead, the Patent Office cites to Lin as allegedly disclosing that cookies correspond to the configuration file of Shih. In particular, the Patent Office argues that:

> Lin discloses the cookies that are a block of text that is used to create a customized service (page 47, section 8.1). Therefore the cookie is used to configure the browser and is a block of text (file) the data is then a configuration file. Therefore the configuration file deleted by Shih corresponds to the deleted cookie recited in the claim.

(Office Action mailed April 7, 2006, p. 4).

Initially, Applicant respectfully submits that no person of ordinary skill in the art would consider a configuration file to correspond to a cookie. A cookie is, as defined in the Lin reference, simply a block of text. Indeed, cookies are simple pieces of data unable to perform any operations by themselves (see Wikipedia definition of "HTTP cookie" at www.en.wikipedia.org/wiki/HTTP_cookie). In contrast, a configuration file is a file, often written in ASCII, that is used to configure the initial settings for computer programs (see Wikipedia definition of "configuration file" at www.en.wikipedia.org/wiki/Configuration_file). Therefore, it is obvious that a cookie is not the same thing as a configuration file.

The Patent Office's faulty reasoning is highlighted by its incorrect statement that the cookie is used to configure the browser. Lin does disclose that cookies can be used to create a customized service. However, a teaching that a customized service can be created is not

equivalent to a cookie being used to configure the browser. A reading of the entire section 8.1 of Lin shows clearly that Lin does not teach that the cookie is used to configure the browser. In fact, a cookie does **not** configure the browser. As set forth above, cookies are simple pieces of data that are unable to perform any operations by themselves. The Examiner points to nothing in Lin or elsewhere that would support a statement that a cookie configures a browser. As such, a cookie does not configure a browser, and therefore, a cookie is not a configuration file. Thus, the deleting of a configuration file as allegedly taught in Shih in light of Lin is not the same as removing the browsing histories, cookies, preferences, and bookmarks as recited in the claim. As such, the references individually do not teach or suggest the claim element. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness and the claims are allowable. Applicant requests withdrawal of the § 103(a) rejection of claims 1-3, 5-11, 13-18, and 27-32 at this time.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Levine in view of Shih and Lin, and further in view of Scan Tech News article. Applicant respectfully traverses. The standard for establishing obviousness is set forth above. As explained above, the combination of Levine and Shih does not show the element regarding removing records pertaining to the computing session from the host computing device to enhance privacy associated with the computing session, said removed records including one or more of the group consisting of browsing histories, cookies, preferences, favorites, and bookmarks from one or more of the group consisting of system memory, cache, and disk drives. The addition of the Scan Tech News article does not cure the deficiencies of the original combination. Thus, the combination of references does not teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish obviousness, and claim 12 is allowable.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: July 5, 2006
Attorney Docket: 4989-008

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